

## REMARKS

In response to the above identified Office Action, the Applicant tenders the remarks set out below and respectfully request reconsideration thereof.

### 1. Summary of the Office Action

Claims 1-4 and 6-8 stand rejected under § 102(e) as allegedly being anticipated by U.S. patent no. 5,898,783 (Rohrbach). Claim 5 stands rejected under § 103(a) as allegedly being unpatentable over by U.S. patent no. 5,898,783 (Rohrbach) in view of U.S. patent no. 4,924,075 (Tanaka). Claims 9 and 10 stand rejected under § 103(a) as allegedly being unpatentable over by U.S. patent no. 5,898,783 (Rohrbach) in view of U.S. patent no. 5,594,657 (Cantone)

### 2. Response to § 102 Rejections

Applicant respectfully traverses this rejection for the reasons set out below, and asks the Examiner for reconsideration.

To anticipate a claim, the reference must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Claim 1, 6 and 8 include the limitation wherein **"the chip of a secure device is provided with a unique chip layout implementing the same algorithms and logic."**

US 5,896,783 discloses a set of SIM cards whose functionality is embedded on a silicon chip. The SIM card is used to identify the user to a telecommunications network, to authenticate that the mobile station is permitted on the network, etc. The SIM card functionality includes data communications circuitry, logic circuitry and disabling circuitry. The logic circuitry includes data processing, storage circuitry and interconnecting circuitry, and also includes a processor, memory, support circuitry and

address, data and control buses (column 4 lines 7-13). The data communications circuitry is operative to transmit a code uniquely identifying the SIM card from logic circuitry within the card, to the telecommunications network via a mobile station (column 4, lines 13-16).

Only one schematic diagram of the layout of a SIM is provided (Fig 2.). The description gives no indication that the layout of the SIM 110 may vary between individual specimens of the SIM used by subscribers in the telecommunications network. Thus, US 5,898,783 does not disclose that, of a number of secure devices, the chip of a secure device is provided with a unique chip layout implementing the same algorithms and logic. Rather, US 5,898,783 discloses that logic circuitry 210 includes storage circuitry (column 4, line 9), and that each SIM transmits a code uniquely identifying the SIM card from the logic circuitry within the card (column 4, lines 13-14). Thus, uniqueness in the prior art is provided by means of a code stored at the same position in the layout of the SIM card in each individual specimen of a SIM card. However, the present invention as claimed in claims 1, 6, and 8 includes the limitation wherein **“the chip of a secure device is provided with a unique chip layout implementing the same algorithms and logic.”** The present invention as defined in pending claims 1, 6, and 8 is consequently novel.

Thus, in view of the above, claims 1, 6, and 8 are submitted to be allowable. As claims 2-5, 7, and 9-10 are dependent upon claims 1, 6, and 8 respectively, they are also allowable.

### 3. **Response to § 103 Rejections**

Applicant respectfully traverses this rejection for the reasons set out below, and asks the Examiner for reconsideration.

To establish a **prima facie** case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the

reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Claims 5, and 9-10 are dependent upon claims 1 and 8 which are submitted to be allowable. Accordingly, claims 5 and 9-10 are also allowable.

Further, regarding claims 1, 6, and 8, US 5,898,783 does not teach or suggest implementing the logic circuitry 210 by means of a layout unique for each individual SIM card out of a number of SIM cards. In the prior art, uniqueness is already provided by means of the stored code. Security is provided by remotely disabling SIM cards which are no longer authorized. However, once the layout of one card has been ascertained by means of probes, one would know at which position in the physical layout of the SIM the unique code is stored. This information could be used to extract the unique code stored in other cards, since the unique code stored in those cards is stored at exactly the same position. By contrast, in the system of the invention, to find out secret information from a second card, knowing the layout of a first card, one would have to re-analyze the second card. This is time consuming and difficult and deters potential hackers from trying to extract secret information from the cards used in the security system according to the invention. Thus, the invention provides an advantage over US 5,898,783 through a unique feature. It is submitted that the invention as defined in claims 1, 6 and 8 is consequently non-obvious and patentable.


#### **4. Conclusion**

Having tendered the above remarks, the Applicant respectfully submits that all rejections have been addressed and that the claims are in a condition for allowance, which is earnestly solicited.

Authorization is hereby given to charge our Deposit Account No. 02-2666 for any charges that may be due. Furthermore, if an extension is required, then Applicants hereby request such an extension.

Respectfully submitted,  
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